



PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of

Souji KIHIRA

Group Art Unit: 2831

Application No.: 10/713,105

Examiner: W. MAYO, III

Filed: November 17, 2003

Docket No.: 117797

For: SHIELDED WIRE HARNESS

REPLY BRIEF

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In reply to the Examiner's Answer mailed July 27, 2005, Appellant submits the following additional comments in response to specific points raised in the Response to Argument section beginning on page 8 of the Examiner's Answer.

I. Formal Matters

The Examiner's Answer appears to suggest, on page 12, line 5 - page 13, line 20, that the recitation of "substantially rigid" is indefinite. However, the prosecution history of this application reveals no rejection under 35 U.S.C. §112, second paragraph, for indefiniteness. Therefore, Appellant understands that this is not an issue on Appeal.

II. Reply to Examiner's Assertions

A. Morgan Does Not Teach A "Substantially Rigid" Metal Pipe

The Examiner's Answer asserts, on page 11, line 11-19, that Morgan teaches rigid shields that are always folded backwards to ensure a good connection between a grounding shield and a cable shield (Morgan, col. 3, lines 41-48). Specifically, the Examiner's Answer

asserts that Morgan teaches a rigid cable 10 that is normally rigid and hard to flexibly bend (Morgan, col. 1, lines 17-18).

The Examiner's Answer then posses the question, on page 11, lines 15-16, "how is it, that the cable is rigid, however, the shield[s] are bend backwards?" In response to its own question, the Examiner's Answer asserts, on page 11, lines 16-19, that "the shield layer is cut horizontally in sections in order to fold individual section[s] of the shield backward[s]... because a rigid shield cannot be folded upon itself, without cuts or slits." Therefore, the Examiner's Answer appears to draw the conclusion that the shield of Morgan must be rigid because the cable itself is rigid and that cuts or slits must be formed to fold back a rigid structure onto itself. These statements in the Examiner's Answer are evidence of the improper and conclusory nature of the rejections based on Morgan.

As discussed in Appellant's Appeal Brief on page 11, lines 25-26, Morgan teaches that a large size of a cable including a plurality of conductors makes the cable rigid and inflexible, thus preventing the large-sized cable from being bent in a curve with a tight radius (Morgan, col. 1, lines 12-16). Therefore, the rigidity of the cable is based on the size of the cable as a whole as asserted by the Examiner's Answer. Morgan does not teach or suggest that the rigidity of the cable is a result of thin-film cable shields.

As discussed in Appellant's Appeal Brief on page 12, line 1-2, Morgan also discloses that bending one of the large cables to form a tight radius often tears the shielding material surrounding the conductors (Morgan, col. 1, lines 16-18). Because the shielding material may be unintentionally torn solely by bending the large cable, it is clear that the outer shield 14 and the inner shield 16 in Morgan are thin, flexible pieces of material that can be easily torn or deformed by mere bending of a cable. The predetermined cuts or slits taught by Morgan may be formed to control unwanted tearing when folding back each flexible shield onto itself.

In view of the foregoing and Appellant's Appeal Brief, Appellant respectfully submits that the Examiner's position regarding the alleged rigidity of the shield taught by Morgan is erroneous and is not supported by Morgan.

B. A Foil Is Not Inherently "Substantially Rigid"

As discussed in Appellant's Appeal Brief on page 14, lines 10-14, Appellant points out that a person of ordinary skill in the art of cable shielding would understand and recognize that the foil shields of Morgan are not substantially rigid. A foil, by definition, is a very thin sheet of metal. Rigid, by definition, means not flexible or pliant. Such very thin sheets of metal, such as aluminum foil, are inherently flexible and non-rigid. Such foils are well suited for shielding layers because the flexible nature of such shielding foils allows the cable to retain its desired flexibility.

C. "Substantially Rigid" Is Not Indefinite and Interpretation of Relative Term of Degree Does Not Teach The Claimed Structure

As discussed above, the Examiner's Answer appears to suggest, on page 12, line 5 - page 13, line 20, that the recitation of "substantially rigid" is indefinite. Because the term "substantially rigid" is not indefinite and this issue is not before the Board on Appeal, the Examiner's Answer improperly relies on guidelines used by the courts regarding indefiniteness under 35 U.S.C. §112, second paragraph. Specifically, the Examiner's Answer improperly relies on a guideline regarding determining a relative term of degree.

The Examiner's Answer asserts, on page 14, lines 3-5, that "[g]iven the above guideline, one would have to assume that the prior art shield, exhibiting the same property as the claimed invention, would also have the same structure." This statement in the Examiner's Answer reflects the speculative and faulty reasoning underlying such a conclusion.

The shield of Applicant's Own Admission of Prior Art (AOAPA) does not have the same structure as the shielded wire harness recited in the claims on Appeal, as alleged in the

Examiner's Answer. Appellant agrees that an armored case of AOAPA and the shielded wire harness of claims 1-6 can fulfill a shielding function and positively protect wire from objects such as bounced stones (page 2, lines 15-18 of the specification). However, as discussed in paragraph 2 on page 5 of Appellant's Appeal Brief, Appellant disagrees that the armored case of the AOAPA would have the same structure as the shielded wire harness recited in the claims. Specifically, the AOAPA does not teach or suggest a shielding member including the combination of a rigid main shield portion and a deformable sub-shield portion. Thus, Appellant respectfully submits that the Examiner's Answer incorrectly asserts that shields exhibiting the same functional properties have the same structure.

The same or similar structure may arguably be considered to inherently have the same or similar properties, but the reverse is not true. The Examiner's Answer relies on such faulty logic to support an apparent allegation of inherency, which is neither correct or supported by any evidence. Therefore, the conclusion reached by the Examiner's Answer is unfounded.

III. Conclusion

For at least the reasons set forth herein and in the Appeal Brief, it is respectfully submitted claims 1-6 are patentable distinct from the applied references. Accordingly, Appellant respectfully requests the Honorable Board to reverse the rejections of claims 1-6 set forth.

Respectfully submitted,



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